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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/641,101
Filing Date: August 17, 2000
Appellant(s): CARLSON ET AL.

Thaddius J. Carvis
For Appellant

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SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed August 9, 2002 and remand mailed September 17, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

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(6) Issues

The appellants' statement of the issues in the brief is substantially correct. The changes are as follows: issue number 3 is no longer an issue because the examiner withdrew the art rejections in Paper No. 14. Appellants acknowledge this fact elsewhere in the brief and presents no arguments with respect to the merits of the withdrawn art rejections. Also, in issue number 2, it appears that "same" should be --some--. The issues can be summarized as follows:

1) Is the rejection of claims 10-17, 19, 20, 22, and 24-42 under 35 U.S.C. 112, first paragraph, as containing new matter proper?

1a) Is the rejection of claims 10-17, 19, 20, 22, and 24-42 under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought proper?

2) Is the rejection of claims 18, 21, and 23 under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based proper?

(7) Grouping of Claims

The rejection of claims 10-17, 19, 20, 22, and 24-42 stand or fall together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 18, 21, and 23 stand or fall together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10-17, 19, 20, 22, and 24-42 stand rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

- i) the connector on the insert member (claims 10-17, 19, 20, 27, 30-32, and 42);
- ii) the insert member attached to the valving member (claims 10-17, 19, 27, 30, 32, and 42);
- iii) the insert member attached to the valve seat (claims 20, 31, and 38);
- iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42);
- v) the valving member being formed from brass or stainless steel (claim 24);
- vi) the insert members made of plastic (claims 15 and 25);
- vii) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13, 14, and 26);
- viii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claims 11 and 27); and
- ix) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40).

Claims 18, 21, and 23 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the

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present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that appellant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During prosecution of US Patent Application Number 09/084,698 (US Patent Number 6,039,304, the basis of the present reissue application), the following subject matter relating to the exact manner in which the insert disk is retained (attached) was introduced into independent claims 1, 15, and 22 in order to avoid art rejections and is subject matter that is surrendered (please note, the amendment to claims 1 and 15 was made in Paper No. 10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance):

“wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”

Appellants' reissue claims 18, 21, and 23 are rejected on the ground of improper recapture of subject matter surrendered during prosecution to avoid art rejections. Reissue claims 18, 21, and 23 have broadened the limitations regarding the exact manner in which the

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disk insert is attached across the fluid passage by reciting that the inserts are merely “attachable across said fluid passage”. Since this broadened aspect of the claims relates to the surrendered subject matter, in that the exact manner of attachment was the same subject matter that was surrendered during prosecution of the original application (i.e. introduced because it was necessary to overcome the art rejections), and since recapture was not avoided (in the reissue claims) by addition of limitations relating to the specific aspect that was narrowed during prosecution (i.e. the exact manner of attachment), the broadening of the claims represents improper recapture.

Claims 10-17, 19, 20, 22, and 24-42 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following subject matter is not supported in the specification.

- i) the connector on the insert member (claims 10-17, 19, 20, 27, 30-32, and 42);
- ii) the insert member attached to the valving member (claims 10-17, 19, 27, 30, 32, and 42);
- iii) the insert member attached to the valve seat (claims 20, 31, and 38);
- iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42);
- v) the valving member being formed from brass or stainless steel (claim 24);
- vi) the insert members made of plastic (claims 15 and 25);
- vii) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13, 14, and 26);

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viii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claims 11 and 27); and

ix) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40).

(11) *Response to Argument*

Argument A (claims 10-17, 19, 20, 22, and 24-42)

Re limitation i) the connector on the insert member (claims 10-17, 19, 20, 27, 30-32, and 42), appellants argue that the flange (ref no. 8 in Fig. 8 of '304) is equivalent in its function to the connector of '890. The examiner disagrees, the flange of '304 does not connect to anything; therefore, it is not a connector. In fact, the limitations added to the independent claims of '304 are directed to the retaining ring (9), which is a necessary component because the insert member has no connectors. In contrast, the connector (48 of '890) connects to either the valving member or the valve seat.

Re limitations ii) the insert member attached to the valving member (claims 10-17, 19, 27, 30, 32, and 42) and iii) the insert member attached to the valve seat (claims 20, 31, and 38), appellants argue that "attach" should be given the broadest reasonable interpretation. However, this is misleading because the limitations not supported recite that the insert member is attached to specific structure (either the valving member or the valve seat). Attaching the insert member to either the valving member or the valve seat is clearly not disclosed by appellants. Appellants further argue that these features are not patentably distinct and therefore not material from the embodiment in appellants' disclosure. It should be noted that 35 USC 112 1st paragraph new matter and 35 USC 251 new matter issues are not related to 35 USC 103 obviousness issues.

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Therefore, the argument is not germane to the rejection of record. Furthermore, since the specifics of the exact nature (how and where) of the attachment of the insert member across the flow path were amended into the independent claims of the '304 patent to overcome the prior art, appellants' arguments that those features fail to constitute patentably distinct features contradict the prosecution history of the patent upon which the present reissue is based (please note, the amendment to claims 1 and 15 was made in Paper No.10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance).

Re limitation iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42), there is no reasonable interpretation of "parabolic" that includes the pie-shaped wedge of appellant. Appellants argue that the '890 patent does not illustrate a true parabolic curve. The examiner disagrees. '890 clearly discloses a parabolic opening for the insert in both the specification and figures (see, for example, Figs. 4, 5, and 7 and column 5, line 26, column 6, lines 6 and 67, and column 7, lines 28 and 35, of the specification). Appellants disclose a pie-shaped wedge (see Figs. 3 or 5), the curved portion of the wedge is circular, not parabolic. Furthermore, appellants' assertion that '890 does not disclose a true parabolic curve (i.e. the disclosure of '890 is not enabling for the claims of '890) is not germane to the issue being argued (i.e. does the disclosure of '304 support the claims of '890).

Re limitations v) the valving member being formed from brass or stainless steel (claim 24) and vi) the insert members made of plastic (claims 15 and 25), these materials are not disclosed by appellants' original disclosure. The argument that a claim limitation should be considered as disclosed if it not disclosed (but considered obvious) is without merit. Issues relating to 35 USC 112 1st paragraph (new matter) and 35 USC 251 (new matter) are not related to 35 USC 103 obviousness issues.

Re limitation vii) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13, 14, and 26), appellants argue that “the inserts having a diameter corresponding to the diameter of the bore of the valving member” should be considered as disclosed because appellants’ insert is larger than the bore diameter and thus has “a diameter” arbitrarily chosen that would correspond to the bore diameter. This claim limitation can not reasonably be read that broadly because it is presented in dependent claims 13 and 26, which must further limit independent claims 10 and 18. The independent claims recite the insert and the insert must inherently correspond or be larger than the bore diameter. To further limit claims 10 and 18, claims 13 and 26 must be read as a distinct diameter on the insert rather than an arbitrarily chosen diameter.

Re limitation viii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claims 11, 27, and 32), these features are not disclosed. Appellants further argue that these features are not patentably distinct and therefore not material from the embodiment in appellants’ disclosure. It should be noted that 35 USC 112 1st paragraph new matter issues and 35 USC 251 new matter issues are not related to 35 USC 103 obviousness issues. Therefore, the argument is not germane to the rejection of record. Furthermore, since the specifics of the exact nature (how and where) of the attachment of the insert member across the flow path were amended into the independent claims of the ‘304 patent to overcome the prior art, appellants’ arguments that those features fail to constitute patentably distinct features contradict the prosecution history of the patent upon which the present reissue is based (please note, the amendment to claims 1 and 15 was made in Paper No.10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance).

Re limitation ix) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40), this limitation is not disclosed. Appellants further argue that these features are not patentably distinct and therefore not material from the embodiment in appellants' disclosure. It should be noted that 35 USC 112 1st paragraph new matter issues and 35 USC 251 new matter issues are not related to 35 USC 103 obviousness issues. Therefore, the argument is not germane to the rejection of record.

Appellants' contention that none of the limitations identified by the examiner is material to patentability is not correct. In fact, four of these limitations are directly related to the manner and location of connection between the insert member and either the valving member or the valve seat. Since the specifics of the exact nature (how and where) of the attachment of the insert member across the flow path were amended into the independent claims of the '304 patent to overcome the prior art, appellants' arguments that those features fail to constitute patentably distinct features contradict the prosecution history of the patent upon which the present reissue is based (please note, the amendment to claims 1 and 15 was made in Paper No.10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance). More importantly, 35 USC 112 1st paragraph new matter issues and 35 USC 251 new matter issues are not related to 35 USC 103 obviousness issues. Therefore, the argument is not germane to the rejection of record.

It is clear that none of the above nine limitations are supported by the originally filed 09/084,698. Appellants' assert that they are permitted to copy claims which contain limitations not found in the original disclosure. Appellants cite 37 CFR 1.606 and MPEP 2305 to support this assertion. The examiner disagrees. There is nothing in 37 CFR 1.606 or MPEP 2305 (or anywhere else) to support appellants' assertion.

Appellants' argument A then digresses into assertions with respect to what could have been done during the prosecution of the reissue application. In what appears to be an admission that addition of new matter is improper, appellants suggest that amendments could have been made during prosecution to claims 19 and 27 eliminating the new matter. These arguments are not relevant to the claims under appeal. The appellants have chosen to present and to prosecute the pending claims. The appellants have further elected to appeal these same claims. Consequently, the claims of record have been examined (claims 1-9 were allowed and claims 10-42 have been finally rejected) and the appeal should only consider the claims of record. It should be noted that if appellants had presented fully supported, broadened, amended claims 19 and 27, they may or may not have been rejected on prior art and would not necessarily be proper interference counts.

Argument B (claims 18, 21, and 23)

Appellants argue that the application of recapture should not be rigid (i.e. automatically applied) and requires analysis of the particular factual situations. The examiner agrees with appellants' statement. That is why the particular factual situation has been analyzed by the examiner. It appears that appellants purport a rigid application of the doctrine of recapture (see page 10, second full paragraph). Appellants state "[i]n *Ball* the CAFC permitted a reissue applicant to proceed with claims which were narrower in some respects and broader in other respects than were the claims in the issued patent. Clearly, Appellants' claims 18, 21, and 23 are claims which the *Ball* Court would not have rejected based on recapture." Appellants advocate a rigid application of the recapture doctrine to permit claims which are narrower in some aspects and broader in other respects without an analysis of the particular factual situations regarding

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what subject matter was surrendered during prosecution of the patent upon which the present reissue is based and what limitations of the reissue claims are broader or narrower. Such a rigid application of the recapture doctrine would not be proper. The application of the recapture rule requires analysis of the particular factual situations regarding what subject matter was surrendered during prosecution of the parent application and what limitations of the reissue claims are broader or narrower. Application of the recapture rule is a multistep process. *Panmu v. Storz Instruments Inc.*, 59 USPQ2d 1597 (CAFC 2001)

The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. In the present situation, reissue claims 18, 21, and 23 are broader than the patent claims in the aspect of how and where the insert members (disks) are attached. Reissue claims 18, 21, and 23 broadly recite that the insert members (disks) are merely “attachable across said fluid passage”. This is much broader than the particular attachment structure in independent claims 1, 4, and 6 of US Patent Number 6,039,304 which require the limitations “wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”.

The second step is to determine whether the broader aspects of the reissued claims relates to the surrendered subject matter. This is clearly the case because the limitations “wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings” were added to the independent claims in order to overcome the art rejections.

The third step is to determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. However, the only respects of the reissue claims that are narrower do not relate to the manner and location of the attachment. Therefore, the reissued claims were not narrowed in other respects to avoid the recapture rule.

The examiner has not applied a rigid doctrine. The examiner has done the requisite analysis of the particular factual situation. Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during the prosecution are impermissible. See, for example, *In re Clement* (CAFC) 45 USPQ2d 1161:

“deliberate withdrawal or amendment does not involve inadvertence or mistake contemplated by Section 251, and recapture rule therefore prevents patentee from regaining, through reissue, subject matter surrendered in effort to obtain allowance of original claims; under this rule, reissue claims that are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution are impermissible.”

Appellants offer no arguments about the particular factual situations regarding what subject matter was surrendered during prosecution of the patent upon which the present reissue is based and what limitations of the reissue claims are broader or narrower. Accordingly, argument B is without merit.

The present appeal has been remanded to the examiner for a determination of whether the recapture rejection remains appropriate in view of *Ex Parte Eggert*. What follows is a discussion of why the recapture rejection remains appropriate and why the decision in *Ex Parte Eggert*, is not applicable to the facts of this appeal.

Background:

Reissue claims 18, 21 and 23 are newly added in the reissue application to provoke interference; these claims are rejected under 35 U.S.C. § 251 based on the recapture doctrine. Claim 18 is an independent claim, while claims 21 and 23 depend from claim 18. Claims 21 and 23 stand or fall with claim 18. In the application for the patent now sought to be reissued, originally filed dependent claims 4 (dependent on claim 1) and 17 (dependent on claim 15), and subsequently added dependent claim 27 (dependent on added claim 22), were objected to, and it was indicated in Office actions that the claims would be allowable if placed in an independent format. (An art rejection was applied to the other claims.)

On amendment in response to the Office actions, the applicant basically incorporated the allowable subject matter of claims 4, 17 and 27 into independent claims 1, 15 and 22, respectively (which became patent claims 1, 4 and 6, respectively). The examiner did not give any reasons as to why claims 4, 17 and 22 contained allowable subject matter. The applicant argued that the prior art did not teach the limitations of claims 22-27 in a reply to an Office Action on June 28, 1999 (paper no. 10). Specifically, the applicant pointed out that the prior art did not teach a casing having at least two parts in which one is screwed into the other.

Analysis and Response to the Remand:

In the present instance, the original independent claims, which were rejected by the examiner based on prior art, did not contain:

Element X: “wherein at least one of the casing openings forms a groove”

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Element Y: “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings.”

To overcome the prior art rejection against the claims not having either limitation X or limitation Y, the applicants rewrote those claims to add limitations X and Y, from the relevant dependent claims. The examiner had suggested that such rewritten claims would be allowable, and the applicant made the choice of inserting those dependent claim limitations into all the claims by re-writing objected to dependent claims 4, 17, and 27 as independent claims. The applicant chose not to prosecute further variations of the original independent claim. At the present, on reissue, applicant is not permitted to completely delete the added limitations. See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), discussed below.

Eggert: The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is **not applicable** to the facts of this appeal. The claims on appeal omit the surrender-generating limitations (i.e., the limitation(s) added in the original prosecution to define over the art to secure allowance of the patent). This is because the limitations of **patent** claims 1, 4 and 6 (that were added from claims 4, 17 and 27 of the original application), which are represented as element X and Y below, respectively, in their entirety, are essentially absent from the **reissue** claims 18, 21 and 23. Therefore, the claims impermissibly recapture what was previously surrendered, as explained in more detail below and in the Examiner’s Answer on pages 5-6.

Patent claims 1, 4 and 6 contain elements X and Y, which were indicated as containing allowable subject matter by the examiner in the patented file.

The reissue claim 18, and its dependent claims 21 and 23, fail to recite both elements X and Y, but instead recite that the disk, called “a *plurality* of disk-shaped inserts” in claim 18, is “attachable across the fluid passage.”

1) The recitation of the inserts or disks being “attachable across the fluid passage” is a functional limitation that is inherently present, - any item, such as a disc, can be attached to another item via a glue, cement, clamp, etc..

2) The new recitation of a “plurality of disk-shaped inserts” in reissue claim 18 in place of the disk in the patent claims is a narrowing limitation (as compared with the patent claims). It is supported in the patent’s specification at column 4, lines 13-14, but is not shown in the drawings. This new narrowing feature of having a disk insert at both the inlet and outlet ports pertains to a feature for altering the fluid flow; the new feature is not related to elements X and Y (whose omission results in surrender), which both pertain to structure for retaining the disk in position.

Accordingly, reissue claim 18, 21 and 23 are broader than the original patent claims 1, 4 and 6 by not including the surrender-generating limitations, elements X and Y, of patent claims 1, 4 and 6. This broadening of the claims is barred by the recapture rule even though there is narrowing of the claims (e.g., a “plurality of disk-shaped inserts”) **not related to** the surrender-generating limitations (e.g., elements X and Y which pertain to structure for securing the disk in position).

In view of *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), if a reissue claim is broader in an aspect germane to what was surrendered in response to a prior art rejection, but narrower in another aspect completely unrelated to what was surrendered, the recapture rule bars the claim. This is the understanding of how the shorthand set forth in

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Clement, 131 F.3d at 1470, 45 USPQ2d at 1165 for the broadening/narrowing scenario 3(a), is applied in light of *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001) both of which pointed out that one should look at the limitation **relied upon to define the invention over the prior art**, and determine if that limitation is omitted in the reissue claims. Note also the statement in *Clement* that every time the claims are narrowed by amendment, subject matter is surrendered. *Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166 ("[E]very time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter.").¹

The limitations of elements X and Y in claims 1, 4 and 6 of the original patent are germane to what was surrendered in response to a prior art rejection, as these claims were indicated allowable when the base claim from which claims 4, 17 and 27 of the original application depended (i.e., claims 1, 15 and 22) was rejected under prior art. Therefore, the limitations of elements X and Y of claims 4, 17 and 27 were necessary in order to secure a patent. Similar to the facts in *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), the applicant has broadened the reissue claims in an aspect germane to what was surrendered in response to the prior art rejection, and has narrowed in an area not related to the surrender. The decision in *Pannu* is on point as to the issues on appeal, because it provides an actual fact situation in which this scenario was held to be recapture. It is noted that the Appeal

¹ This statement that every time the claims are narrowed by amendment, subject matter is surrendered, calls for analyzing reissue claims for whether a key narrowing that was made in the original prosecution has abandoned, i.e., surrendered, subject matter that the patent owner is now seeking to recapture by reissue. Thus, the insertion of a narrowing unrelated to the abandoned (surrendered) claim subject matter that owner is impermissibly trying to recover does not save the claim from the recapture doctrine.

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Brief states on pages 9-10 that reissue claims 18, 21 and 23 "...are narrower in some respects and broader in other respects than were in Appellants' initial claims." Applicant, however, fails to specifically point out what are the narrowing respects. In this instance, there is no apparent replacement narrowing limitation that relates to the surrender-generating limitations, which pertain to how the disk is secured in position.

Because reissue claims 18, 21, and 23 omit the surrender-generating limitations, elements X and Y, and fail to include a replacement limitation in the area of the surrender, *Pannu* is on point while *Eggert* is not, and claims 18, 21, and 23 impermissibly recapture what was previously surrendered.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Eric Keasel 22 JUL 2004

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